

## **RECORD OF TELEPHONE INTERVIEW**

The undersigned wishes to express his appreciation to the Examiner for the courtesies extended to him during their telephone interview of January 26, 2005. The undersigned had called the Examiner to advise that copies of the references identified in the Information Disclosure Statement (IDS) had been mailed to the Patent and Trademark Office (PTO) with the IDS, and that the PTO must have lost those copies. The undersigned suggested that it would be appropriate for the Examiner to consider the references, especially in view of a rule change no longer requiring submission of copies of U.S. Patents with an IDS. The Examiner graciously agreed to consider the references listed in the IDS, which he did.

## **REMARKS**

Reconsideration of the present application is respectfully requested.

The specification of this application has been amended by this response to correct spelling and grammatical errors in the specification as filed. Also, paragraph [1] of the application has been deleted.

Claims 8,9 and 15-18 are in the application, with claims 15-18 being added by this response.

Claims 1-14 were in the application as filed. In the Office Action, the Examiner (a) rejected claims 1-14 under the provisions of 35 U.S.C. § 112, ¶ 2 as indefinite, taking the position that it is unclear what is meant by a shield-less obturator; (b) rejected claims 1-5, 10 and 11 under the provisions of 35 U.S.C. § 102 based on U.S. Patent No.

5,405,328 to Vidal; and (c) rejected claims 6-9 and 12-14 under the provisions of 35 U.S.C. § 103 based on the combination of the Vidal patent and U.S. Patent No. 5,118,297 to Johnson.

#### **A. Claim Construction Matters**

En route to making his rejections, the Examiner provided his comments on various aspects of claim construction. In view of the Examiner's comments with respect to the term "integral," all pending claims now use the term "monolithic" to refer to a unitary structure. Support for the term "monolithic" is found in paragraph [14] of the specification.

In the Office Action, the Examiner took the position that the term "disposable" "is considered a functionally valueless term." According to the Examiner, "[a]nything can be considered disposable in that all you have to do is throw it away." (Office Action, p.2). Applicant respectfully disagrees.

The Examiner's attention is invited to U.S. Patent No. 5,871,471 to Ryan, copy attached as Exhibit A. The Ryan patent, which issued on an application filed in 1995, discusses both reusable and disposable trocars. The Ryan patent discusses that a large disposable trocar market has emerged as a result of the difficulties in cleaning the valves of reusable trocars. (Exhibit A, col. 1, line 57-67). As of the date that the present application was filed, a person of ordinary skill in the art would have understood that a disposable obturator is an obturator which is discarded after use on the first patient. (O'Heeron Declaration, Exhibit B, ¶ 5; see U.S. Patent No. 5,817,061 to Goodwin

(Exhibit C) (disclosing for example in the Abstract a disposable obturator tip which is disposed of after use on the first patient).

Finally, as the Examiner's comments are understood, he is asserting that no distinction exists between a cutting tip and a tissue-separating tip. Again, Applicant respectfully disagrees. As of the filing date of the present application, a person of ordinary skill in the art would have understood the distinction between a cutting tip and a tissue-separating tip. (O'Heeron Declaration, Exhibit B, ¶ 6; *see also* U.S. Patent 6,835,201 to O'Heeron (Exhibit D) (discussing in the Background cutting tips and tissue separation tips).

#### **B. The § 112 Rejection should not be Maintained**

In making the §112 rejection, the Examiner asserted that it is unclear what is meant in the claims as filed by the term "shield-less" obturator. Since the limitation "shield-less" appears in the claims added by this amendment, the § 112 rejection is addressed.

The Examiner's attention is invited to paragraph [14] of the specification where it is discussed that disposable obturators other than in accordance with the present invention have an internal or external shield and that "this obturator [i.e., one in accordance with the present invention] is designed to work without a shield or with a shield on the instrument cannula." The specification thus defines a shield-less obturator to be an obturator without a shield.

Accordingly, Applicant submits that the specification provides a definition for “shield-less” and the §112 rejection should not, therefore, be maintained.

### **C. The Pending Claims Define Patentable Subject Matter Over Vidal and Johnson**

The Examiner relied on the Vidal patent in the Office Action mailed January 11, 2005 to make his §102 and §103 rejections. The Vidal patent discloses an obturator comprising a proximal portion 201 and a plurality of distal portions 210-215 (see FIGS. 15 and 16). The distal portions 210 –215 are releasably attachable to the proximal portion 201 (Col. 12, ln. 47-49). Paragraph [20] of the present application discusses the advantages of the present invention over a system such as shown in the Vidal patent.

The Examiner relied on the Johnson patent (in combination with Vidal) to make the §103 rejections contained in the Office Action mailed January 11, 2005. Substantial differences exist between the present invention and what is described in the Johnson patent.

First, the Johnson patent does not describe an obturator for use in endoscopic surgery. Rather, the Johnson patent describes an obturator for use in providing an endodontic filler application (Col. 3, ln. 20-23). Thus, while the present invention is directed to a surgical device, the Johnson patent is directed to a dental device for use in a root canal procedure.

Second, the Johnson patent discloses a plurality of raised indicators 20 which are described as length (i.e. depth) indicators (Col. 3, ln. 58-61). Indicators 20 indicate the depth of the obturator, not the orientation of the distal end of the obturator, as recited in

the present claims. Further, indicators 20 in the Johnson patent are located near the middle of the length of the obturator, not near the proximal end of the obturator, as recited in the present claims. Further, the indicators 20 in Johnson are visual indicators, not indicators which enable the user to determine by touch the relative position of the tip at the distal end, as recited in the present claims.

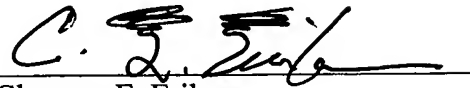
The Johnson patent also discloses other visual indicators 24 (FIG. 1) and 24A (FIG. 6) which indicate the shaft diameters. While these visual indicators of Johnson are located near the proximal end of the trocar, they are not orientation indicators, which enable the user to determine by touch the relative position of the tip at the distal end of the obturator.

Accordingly, Applicant submits that claims 8-9 and 15-18 define patentable subject matter over the Vidal and Johnson patents, taken either individually or in combination.

#### **D. Conclusion**

The pending claims are allowable, and early allowance of these claims is solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "C. E. Eriksen", written over a horizontal line.

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